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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/664,806      | 09/17/2003  | Timothy K. Searfoss  | 3000/22             | 3469             |

7590 09/07/2004

Cardinal Law Group  
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EXAMINER


GUTMAN, HILARY L

ART UNIT PAPER NUMBER

3612

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/664,806 | <b>Applicant(s)</b><br>SEARFOSS, TIMOTHY K.  |  |
|                              | <b>Examiner</b><br>Hilary Gutman     | <b>Art Unit</b><br>3612  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority/Oath/Declaration***

1. The application improperly claims priority to itself.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 7-8, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Swanson et al.

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Swanson et al. (6,513,856) disclose a rail 46 for a top of a wall 15 of a trailer 16, the rail comprising: a body adapted to engage the top of the wall, the body having a concave surface (Figure 6) adapted to receive a cover reel 22.

With regard to claim 2, the concave surface faces away from the trailer.

With regard to claim 3, at least one leg (Figure 6) is connected to the body.

With regard to claim 4, the at least one leg is adapted to engage the top of the wall.

With regard to claim 7, the body includes an opening (generally formed by the concave surface) adapted to anchor a cover 20.

With regard to claim 8, the body extends at least a majority of a length of the wall of the trailer (Figure 1).

For claims 5 and 11, it should be noted that the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process (MPEP 2113).

5. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al.

Miller et al. (5,984,400) disclose a rail 42 for a top of a wall (Figure 1) of a trailer, the rail comprising: a body (Figure 3) adapted to engage the top of the wall, the body having a concave surface (generally at 56) adapted to receive a cover reel 30 (Figure 5).

With regard to claim 6, the body comprises a plurality of ribs 60, 62

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12-16, 18-19, 22-27, 29-30, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson et al. in view of Searfoss (6,206,449).

For claim 12, Swanson et al. disclose an apparatus for extending and retracting a cover 20 over a trailer 16, the apparatus comprising: a base 28 (Figures 2-3) pivotably connected to the trailer; an extension 26 connected to the cover and connected to the base; and a rail 46 for a top of a wall 15 of the trailer 16, the rail 46 including a body adapted to engage the top of the wall, the body having a concave surface (Figure 6) adapted to receive a cover reel 22.

For claim 23, Swanson et al. disclose an apparatus for extending and retracting a cover 20 over a trailer 16, the apparatus comprising: a base 28 pivotably connected to the trailer; an extension 26 connected to the cover and connected to the base; a reel 22 connected to the extension; a motor 25 mounted on the extension and drivingly engaged with the reel to selectively extend and retract the cover over the trailer; and a rail 46 for a top of a wall 15 of the trailer 16, the rail 46 including a body adapted to engage the top of the wall, the body having a concave surface (Figure 6) adapted to receive the reel.

With regard to claims 13 and 24, the concave surface faces away from the trailer.

With regard to claims 14 and 25, at least one leg (Figure 6) is connected to the body.

With regard to claims 15 and 26, the at least one leg is adapted to engage the top of the wall.

With regard to claims 18 and 29, the body includes an opening (generally formed by the concave surface) adapted to anchor a cover 20.

With regard to claims 19 and 30, the body extends at least a majority of a length of the wall of the trailer (Figure 1).

For claims 16, 22, 27, and 33, it should be noted that the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process (MPEP 2113).

Swanson et al. lack the extension being pivotably connected to the base.

Searfoss (6,206,449) teaches an apparatus for extending and retracting a cover over a trailer, the apparatus comprising: a base 24 pivotably connected to the trailer; and extension 26 connected to the cover and pivotably connected to the base; and a rail 58.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided an extension as taught by Searfoss that is pivotable to the base of Swanson et al. in order to provide the cover with more flexibility when moving between extended and retracted positions.

8. Claims 12, 17, 23, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson et al. in view of Schmeichel et al. (4,505,512).

Swanson et al. lack the body comprising a plurality of ribs.

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Schmeichel et al. teach an apparatus for extending and retracting a cover over a trailer, the apparatus comprising: a rail 24 having a body (Fig. 4) with a plurality of ribs 44, 50, 52, 54.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a plurality of ribs as taught by Schmeichel et al. upon the rail of Swanson et al. in order to stiffen and strengthen the rail.

9. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson et al. as applied to claim 1 above, and further in view of the well known prior art.

Swanson et al. lack the body of the rail being aluminum or a polymer.

The well known prior art (Hall, Jr. 5,791,714 and Muirhead 6,588,826) teaches aluminum and polymer materials for use with vehicles since these materials exhibit advantageous properties in that they can be lightweight, anticorrosive, and durable.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have created an aluminum or polymer body for the rail of Swanson et al. since the well known prior art teaches advantageous characteristics of these materials for use in a similar environment.

10. Claims 20-21 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson et al. as applied to claims 12 and 23, above, respectively, and further in view of the well known prior art.

Swanson et al. lack the body of the rail being aluminum or a polymer.

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The well known prior art (Hall, Jr. 5,791,714 and Muirhead 6,588,826) teaches aluminum and polymer materials for use with vehicles since these materials exhibit advantageous properties in that they can be lightweight, anticorrosive, and durable.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have created an aluminum or polymer body for the rail of Swanson et al. since the well known prior art teaches advantageous characteristics of these materials for use in a similar environment.

### *Response to Arguments*

11. Applicant's arguments filed 8/13/04 have been fully considered but they are not persuasive.

The applicant states that in Swanson et al. the ledge 46 is "attached on side 15" of the trailer. However, the examiner notes that the ledge 46 is also attached at the top of the trailer.

With regard to Miller et al. the applicant states the channel 56 is not concave. The examiner believes this channel to be generally concave since it extends inwardly and is generally C-shaped. Furthermore, it can be adapted to receive the cover reel as required by the claimed channel (and functionally satisfies the claim language).

### *Conclusion*

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**



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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hilary Gutman whose telephone number is 703-305-0496.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 703-308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14. **Any response to this final action should be mailed to:**


Box AF  
Assistant Commissioner for Patents  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9327, (for formal communications; please mark "EXPEDITED PROCEDURE")

**or:**

(703) 746-3515, (for informal or draft communications, please clearly label "PROPOSED" or "DRAFT").

  
DENNISH. PEDDER  
PRIMARY EXAMINER  
AU3612 9/2/04